

## **REMARKS**

The Applicants respectfully request reconsideration in view of the following remarks. Claims 1 and 8 have been amended. Claims 6 and 10 were previously cancelled and claims 2, 7, and 11 are currently cancelled. Claim 12 has been added. Accordingly, claims 1, 3-5, 8, and 9 are pending in the application.

### **I. Claims Rejected Under 35 U.S.C. § 102**

Claims 1-5, 8 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,853,327 issued to Gilboa (hereinafter "Gilboa").

To anticipate a claim, a single reference must disclose each element of that claim. Thus, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Also, "[t]he elements must be arranged as required by the claim." *See In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) and MPEP § 2131.

In regard to claim 1, this claim has been amended to recite "the element comprises a means (100, 102) of receiving game control information by wireless transmission, a control means (112, 114) sensitive to the received information, wherein the element has its own address for reception of said received information" (emphasis added). This amendment is intended to clarify the subject matter of the claim and does not add new subject matter to the claim. The Applicants respectfully submits that the Examiner continues to misconstrue the Gilboa reference.

The Examiner cites column 4, lines 42-46 of Gilboa as allegedly teaching the above cited elements of claim 1. However, the different frequencies cited in this paragraph of Gilboa do not allow the wireless sending/transmission of controls to different game elements. More particularly, it is very clear in the cited paragraph that although signals are transmitted in Gilboa, these signals originate at the game elements and are transmitted to the game board. Specifically, these different frequency signals are transmitted by the game elements for the purpose of identifying the elements and their locations on the game board. However, Gilboa does not disclose that the game elements receive control signals. Instead, it is the game board that receives signals from the game elements. Further, there is no objective teaching or suggestion in Gilboa that signals could be used in the reverse direction such that the board transmits control

signals to the game elements, because Gilboa does not discuss controlling the game elements via control signals.

In addition, in response to the Applicant's argument in the Response to Office Action mailed October 13, 2008, the Examiner mentions figure 18C and the corresponding description at column 20, lines 8-13 of Gilboa to allegedly show that game pieces in Gilboa are not only moved through player interaction but are also moved by the "game itself." See Final Office Action, Pages 5 and 6. Specifically, the Examiner argues that a solenoid actuator indirectly moves the games pieces independent of player interaction. See *Id.* However, it appears that the solenoid of Gilboa is located in a housing for which there is no indication that it is movable. Therefore, the solenoid belongs to the game board and not to a movable game element.

Moreover, as the solenoid is fixed, a person of ordinary skill in the art would use wires to control the solenoid, because there would be absolutely no necessity for a far more costly and less reliable wireless control in such a case. Further, as wires in this case define point-to-point connections between transmitters and receivers, there is no requirement for a scheme where each solenoid would have its own address, because point-to-point communications do not rely on addressing information to transmit and receive data. In contrast, claim 1 recites that the element has its own address.

By providing individual addresses for elements on a game board, claim 1 provides a gaming system where independent and movable game elements can be individually controlled by wireless instructions. Thus, Gilboa fails to anticipate claim 1 by failing to disclose the recited elements of claim 1.

Further, claim 1 has been amended to recite "a means (116) for animating the element controlled by the control means." These amendments are supported, for example, by original claim 2 which has been cancelled. The Examiner has not cited any sections and the Applicants have been unable to locate any sections of Gilboa which teach animating the game elements. Further, the battery taught by Gilboa is a battery with transponder type circuitry which is not designed for powering animation. Therefore, Gilboa could not provide adequate power for animation purposes. Thus, Gilboa fails to teach this element of amended claim 1.

Moreover, claim 1 has been amended to recite "the element is powered by a rechargeable battery and the game board and the element comprise positions for recharging the rechargeable battery of the element." These amendments are supported, for example, by original claim 7

which has been cancelled. The Examiner acknowledges that Gilboa fails to disclose a rechargeable battery but argues that it would have been obvious to incorporate a rechargeable battery into the system of Gilboa which uses a replaceable batter, because rechargeable and replaceable batteries are functionally interchangeable. However, the element of amended claim 1 incorporates positions that allow the rechargeable battery of the element to be recharged with a game board. The Applicants submit that this element of amended claim 1 would not be obvious to a person of ordinary skill in the art. Thus, Gilboa fails to teach this element of amended claim 1.

For at least the reasons provide above, Gilboa fails to teach each element of amended claim 1. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejection of this claim.

In regard to claim 8, this claim has been amended to recite elements analogous to those of claim 1. For at least the reasons discussed above in regard to the 35 U.S.C. § 102 rejection of claim 1, Gilboa does not disclose each element of claim 8. Thus, Gilboa fails to teach this element of claim 8. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejection of this claim.

Claims 3-5 and 9 depend from independent claims 1 and 8, respectively, and incorporate the limitations thereof. The Examiner's argument assumes that Gilboa discloses all elements of claims 1 and 8 which are incorporated in dependent claims 2-5 and 9. However, as discussed above, Gilboa does not disclose all the limitations of claims 1 and 8. Therefore, claims 2-5 and 9 are not anticipated by Gilboa. Accordingly, the Applicant respectfully requests reconsideration and withdrawal of the rejection of these claims.

## **II. Claim Rejections under 35 U.S.C. § 103**

Claims 7 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilboa.

The rejection of these claim is moot because these claims have been cancelled.

## **III. New Claims**

The Applicants submit new claim 12. This new claim is supported, for example, by original claims 8 and 11. Further, this claim recites elements analogous to those of claim 1. For

at least the reasons discussed above in regard to the 35 U.S.C. § 102 rejection of claim 1, Gilboa does not disclose each element of claim 12. Thus, Gilboa fails to teach this element of claim 8. Accordingly, the Applicants respectfully request entry and allowance of this claim at the Examiner's earliest convenience.

#### **IV. Additional Amendments**

Additional amendments were made to the claims to improve their clarity and to comply with all formality requirements. The Applicants submit that these amendments do not add new subject matter to the specification. Accordingly, the Applicants respectfully request entry of these amendments.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-5, 8 and 9, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

### PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on January 21, 2009, Applicant respectfully petitions Commissioner for a one (1) month extension of time, extending the period for response to May 14, 2009. The amount of \$65.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(1) small entity will be charged to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

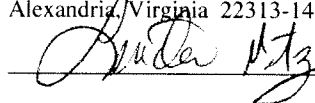
Dated: 5/17, 2009

  
Eric S. Hyman, Reg. No. 30,139

1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040  
(310) 207-3800

#### **CERTIFICATE OF MAILING:**

I hereby certify that this paper is being transmitted online via EFS Web to the Patent and Trademark Office, Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia 22313-1450, on May 14, 2009.



5/14/09  
Date